

REMARKS

The present amendment is being presented after the "final" rejection, but it represents a good faith attempt by Applicants to better distinguish the claimed invention from the teaching in the prior art and to avoid an appeal. All of the amended claims have subject matter that was previously searched and thus a new search will not be necessary and no new issue is raised thereby. The amendments were also prompted by the Examiner's further comments in the "final" rejection. Entry of the amendments is therefore respectfully requested.

Claims 1, 10-12, 14-16 and 20 have been amended, Claims 9 and 13 have been cancelled and new Claims 24-38 have been inserted. Claims 1-8, 10-12 and 14-38 are, therefore, presently pending.

Claim 1 has been limited by the introduction of the subject matter of Claims 9 and 13 with consequent cancellation of Claims 9 and 13. Claims 10-12 and 14-16 have been amended as to their dependency to depend on Claim 1. No new matter has been introduced and these amendments do not require additional searching.

Claim 20, which is a method claim that was withdrawn from consideration as a result of an election made in response to the Office Action dated 30 January 2003, has been limited in a manner corresponding to amended Claim 1 and it is therefore requested that method Claim 20 be rejoined with the composition Claim 1 and dependent claims. No new matter has been introduced and this amendment does not require additional searching.

Claims 21-23 were withdrawn from consideration as a result of a restriction requirement raised in the Office Action dated 30 January 2003 and will be made the subject of a divisional application.

New independent Claim 24, which is directed toward a photographic developer composition, has been inserted. There is support for new Claim 24 in original Claim 1 and it has been limited in respect of the definition of formula II. No new matter has been introduced as the claim is entirely within the scope of original Claim 1 and the claim does not, therefore, require additional searching, the limitations serving only to distinguish over the prior art. Entry is therefore requested.

New Claims 25 to 36 have been inserted being dependent upon Claim 24 and corresponding to original Claims 2-12 and 17. No new matter has been introduced and entry is therefore requested.

New Claim 37, being dependent on Claim 1 and having support in original Claim 14, has been inserted.

New independent Claim 38 has been inserted, for which there is support in original Claims 1, 7 and 14. No additional matter has been added and Claim 38 is entirely within the scope of currently amended claim 1, so no additional searching is required. Entry is, therefore, requested.

Reconsideration of the pending claims in view of the above amendments and following remarks is respectfully requested.

Rejection Under 35 USC § 103 (a)

The Office Action has rejected Claims 1-19 as being unpatentable over Kramp et al., US Patent No. 4,254,215. This rejection is respectfully traversed for the following reasons and it is requested that this rejection be reconsidered and withdrawn.

Claim 1 has now been amended to include the subject matter of Claims 9 and 13 and now further requires that the developer composition comprises a thiol promoting compound selected from sugar derivatives, mercaptocarboxylic acids and compounds selected from those having formula Q – S – H (formula III), wherein Q represents a substituted or unsubstituted heterocyclic group, the silver salt of said compound having formula (III) being water insoluble or water soluble.

It is submitted that the invention as defined in currently amended Claim 1 is patentable over Kramp et al.

Kramp et al. is concerned with a process for the prevention of darkening and the formation of sediment in a developer solution. It discloses a developer solution containing a combination of (a) an organic thiol or thione compound capable of tautomerism and (b) a Bunte salt containing groups that confer solubility in water. It teaches (at column 2, lines 46-54) the use of the process when developing black and white, reversal, chromogenic, X-ray or silver dye-bleach material. The organic thiol or thione compounds according to the invention disclosed in Kramp et al. are defined by formulae 1 and 2 at column 2, lines 55-64 and thereafter.

The only thiol compound specifically disclosed in Kramp et al. that falls within the scope of either formula (I) or formula (II) as defined in currently

amended Claim 1 of the present application is compound 9 at column 13 of Kramp et al., which corresponds to formula (II) of Claim 1 when A = para-phenylene, R¹ = ortho-phenylene, X = SO₃H and M = H.

However, there is no disclosure in Kramp et al. of a thiol promoting compound as defined in currently amended Claim 1.

In order for the skilled person in possession of the teaching of Kramp et al. to reach the invention defined by Claim 1 of the present application, it would be necessary for the skilled person to first select the compound 9 at column 13 of Kramp et al. from a list of over 100 specifically disclosed compounds and then to incorporate into the developer composition a thiol promoting compound. This is not an obvious selection.

The skilled person would not be led by the teaching of Kramp et al. to incorporate a thiol promoting compound into the developer solution, in order to increase or maintain the amount of thiol and minimize Bunte salt formation (see page 22, lines 23-25 of the present application), because Kramp et al. consistently teaches that both the thiol and a Bunte salt should be included in the developer composition, and indeed that the presence of both the thiol and a Bunte salt is preferable to either the thiol or Bunte salt alone (see column 22, lines 34-49 and Example 3 of Kramp et al.). There is no motivation to the skilled person in possession of Kramp et al. to include a thiol promoter compound and no indication or suggestion that such a compound would be beneficial. Section 103 requires that the cited art provide the motivation, not the Applicants' application or the Examiner's speculation. Kramp et al. fails in this regard. The present invention as defined by currently amended Claim 1 and claims dependent thereon is, therefore, not obvious in view of Kramp et al.

Accordingly, it is requested that the rejection under 35 USC § 103 (a) be reconsidered and withdrawn in respect of currently amended Claim 1.

Claim 20, which has been amended to be limited in a manner corresponding to amended Claim 1, is also believed to be unobvious in view of Kramp et al., for the same reasons as for currently amended Claim 1 above.

New Claim 24 corresponds to original Claim 1, but with the further limitation to the definition of formula II that R¹ in formula II is a substituted or unsubstituted aliphatic or alicyclic group.

It is submitted that the invention as defined in new Claim 24 is also patentable over Kramp et al.

There is no disclosure in Kramp et al of any compound falling within the scope of formula I or II of Claim 24. Compound 9 at column 13 of Kramp et al corresponds to formula (II) of Claim 24 when A = para-phenylene, R¹ = ortho-phenylene, X = SO₃H and M = H. However, R¹ of formula II in Claim 24 is limited to a substituted or unsubstituted aliphatic or alicyclic group and so compound 9, where R¹ is an ortho-phenylene group, is not within the definition. The skilled person in possession of Kramp et al. would not be led to the invention as defined in Claim 24 because there is no indication or suggestion that a compound falling within the scope of formula I or II would be beneficial in inhibiting sludge deposition during development.

With regard to the Examiner's assertion that compounds 6, 7 and 8 at column 9, compounds 1 and 2 at column 11 and compound 3 at column 12 of Kramp et al. render obvious "analogues" having "reverse amido groups" falling within the scope of formula II of new Claim 24 (which corresponds to original Claim 1, but with a further limitation as to the definition of formula II, as set out above) with the authority stated in *In re Ward*, 141 USPQ227, *In re Carabateas*, 148 USPQ 282 and *In re Wetterau*, 148 USPQ 499, it is respectfully submitted that the relied upon authorities are concerned with the analogous ester compounds and not to "reverse amido groups" and therefore are not proper authority for the point raised by the Examiner. It is submitted, in any case, that "reverse amido groups" are not commonly considered to be analogues and, in fact, reversing the direction of the amido group would be expected to confer quite different properties upon the compound as a whole, as a result of, for example, the quite different electronic effects as well as conformational changes. Such a reversal of the amido group would generate an entirely different class of compounds, which would not be expected to have similar properties to the original class. Accordingly, a showing of, for example, the compounds 1 and 2 at column 11 and compound 3 at column 12 of Kramp et al. does not render *prima facie* obvious those compound having respectively "reversed" amido groups. The same argument applies to compounds 6, 7 and 8 at column 9 of Kramp et al., from which the compounds defined in formula II of Claim 24 are still further distinguished by the presence in those compounds of Kramp et al. of an aromatic group as R¹ (compounds 6 and 7) and the absence of an NH group (compound 8).

The invention as defined by Claim 24 and claims dependent thereon is, therefore, believed to be unobvious in view of Kramp et al.

Accordingly, it is requested that the rejection under 35 USC § 103 (a) be reconsidered and withdrawn in respect of Claim 24.

New Claim 38, which corresponds to currently amended Claim 1, but is further limited to compounds of formulae I and II in which A and B are paraphenylene and R¹ and R² each represent -(CH₂)₃- and to the presence in the composition of mercaptosuccinic acid, for which there is basis in original Claims 1, 7 and 14, is believed to be unobvious in view of Kramp et al. for the same reasons as currently amended Claim 1.

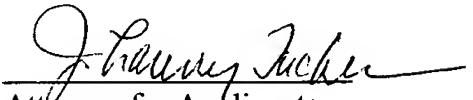
Accordingly, it is requested that the rejection under 35 USC § 103 (a) be reconsidered and withdrawn in respect of Claim 38.

The Examiner states that the language of the claims relating to "an amount sufficient to inhibit sludge deposition" has and is given no value as a supposition only. It is requested that this rejection be reconsidered and withdrawn.

It is respectfully submitted that a skilled person in the art would understand that when presented with a developer composition comprising a compound falling within one of the definitions in the claims which is effective in inhibiting sludge deposition that this developer composition would be within the scope of the claims only if that compound was present in an amount sufficient for it to elicit its sludge deposition inhibiting effect. The requirement that the compound be present in an amount sufficient for it to inhibit sludge deposition is proper and would be clear to a person skilled in the art.

In view of the foregoing remarks, reconsideration of this patent application is respectfully requested. A prompt and favourable action by the Examiner is earnestly solicited.

Respectfully submitted



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